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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,557	07/20/2001	Jean M. Beaupre	END-778	8228

27777 7590 12/28/2006

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EXAMINER	
PHILOGENE, PEDRO	
ART UNIT	**PAPER NUMBER**
3733	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/28/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/909,557	BEAUPRE, JEAN M.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23,26,27,29 and 32-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23,26,27,29,32-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 23, 26, 27, 29, 32-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,436,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent fail to recite a node and a central ridge. The concave surface of the ridge may have the same or a different width as the convex surface. Therefore, inherently there is a ridge. It would have been obvious to one having ordinary skill in the art to place a node at the distal end of the rod and the proximal end of the end effector to maximize vibrations at the distal end of the effector and to minimize vibrations in he handle. Additionally, a "node" is based upon the intensity and frequency of the vibrations applied. Furthermore, it is clear that all the elements of claims 23,26,27,29,32-34 are to be found in claims 1, 13 (as they

encompass claims 2, 14). The difference between the claims of the application and the claims of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of the claims of the patent is in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See in re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims of the application are anticipated by the claims of the patent, they are not patentably distinct.

Claims 23, 26, 27, 29, 32-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,328,751. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent fail to recite a node and a central ridge. The concave surface of the ridge may have the same or a different width as the convex surface. Therefore, inherently there is a ridge. It would have been obvious to one having ordinary skill in the art to place a node at the distal end of the rod and the proximal end of the end effector to maximize vibrations at the distal end of the effector and to minimize vibrations in he handle. Additionally, a "node" is based upon the intensity and frequency of the vibrations applied. Furthermore, it is clear that all the elements of claims 23,26,27,29,32-34 are to be found in claims 1, 5,13 (as they encompass claims 2, 12,14). The difference between the claims of the application and the claims of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of the claims of the patent is in effect a "species" of the "generic" invention of the claims of the application. It

has been held that the generic invention is "anticipated" by the "species". See in re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims of the application are anticipated by the claims of the patent, they are not patentably distinct.

Claims 23, 26, 27, 29, 32-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,309,400. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent fail to recite a node and a central ridge. The concave surface of the ridge may have the same or a different width as the convex surface. Therefore, inherently there is a ridge. It would have been obvious to one having ordinary skill in the art to place a node at the distal end of the rod and the proximal end of the end effector to maximize vibrations at the distal end of the effector and to minimize vibrations in he handle. Additionally, a "node" is based upon the intensity and frequency of the vibrations applied. Furthermore, it is clear that all the elements of claims 23,26,27,29,32-34 are to be found in claims 1, 10 (as they encompass claims 2, 11,12). The difference between the claims of the application and the claims of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of the claims of the patent is in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See in re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims of the application are anticipated by the claims of the patent, they are not patentably distinct.

Response to Amendment

Applicant's arguments filed 10/11/06 have been fully considered but they are not persuasive. The incorporation of the subject matter of claim 25 in claim 23 in the application did not overcome the rejection in the last Office Action. The subject matter of claim 25 is fully disclosed in claims 2 and 13 of patent 6,436,115. Also, the subject matter of claim 25 of the application is fully disclosed in claims 2 and 14 of patent 6,328,751. Finally, the subject matter of claim 25 of the application is fully disclosed in claims 2,11 and 12 of patent 6,309,400. Therefore, claim 23 stands rejected and this action is made final.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-

4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
December 12, 2006

PEDRO PHILOGENE
PRIMARY EXAMINER